

REMARKS

Applicants respectfully request an interview with the examiner before another Office Action is sent from the USPTO.

In the Office Action of May 30, 2006, claims 66-86 are rejected pursuant to 35 U.S.C. 112, first paragraph, as containing subject matter not described in the specification. Specifically, the limitation that “the distal portion is more flexible than the proximal portion such that the distal portion more easily deflects relative to the proximal portion” was pointed out as being inaccurate. By this amendment, claims 66 and 84 have been amended to accurately reflect an intermediate portion of a catheter body having proximal and distal segments, wherein the distal segment is more flexible than the proximal segment.

In addition, the office action maintains that such an intermediate structure is not originally disclosed in association with the Fig. 13A embodiment. Applicant disagrees. The test for support of a claim limitation under §112, first paragraph, is whether the specification when read as a whole reasonably conveys to one skilled in the art that the inventors were in possession of the claimed subject matter. *Vas-Cath Inc. v Mahurkar*, 935 F.2d 1555, 1562 (Fed. Cir. 1991). The office action is applying an incorrect test that requires an express description of the limitation as to each embodiment. However, the test is not whether there is presence or absence of literal support. *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570 (Fed. Cir. 1985). “Compliance with the written description requirement is essentially a fact-based inquiry that will ‘necessarily vary depending on the nature of the invention claimed.’” *Enzo Biochem v. Gen-Probe, Inc.*, 296 F.3d 1316, 1324 (Fed. Cir. 2002) (citation omitted).

This limitation of the claim concerns the general structure of the catheter body, which is an element common to all embodiments disclosed in the specification. There is no dispute that the limitation is literally disclosed in the specification in connection with Fig. 4. Applicant submits that because of the commonality of the structures of Figs. 4 and 13 and of the intended use of those structures, the aspect of an intermediate portion with proximal and distal segments of dissimilar flexibility would be understood by one skilled in the art to be carried over as a variation of the catheter body 402.

The office action also asserts that there is nothing in the specification to indicate any variation in the structure of Fig. 13. See office action at page 3. In fact, however, the specification gives clear instruction to one skilled in the art to adopt and employ features from among and between the various structures described in relation to Fig. 13. See page 47. The office action provides no facts, aside from the absence of a literal reference in regard to Fig. 13 of an intermediate portion in accordance with Fig. 4, in support of the position that the specification does not convey to one skilled in the art the inventors were in possession of the claimed subject matter.

The written description requirement of 35 U.S.C. 112, first paragraph, merely serves to insure that the inventor had possession, as of the filing date, of the specific subject matter later claimed. How the specification accomplishes this is not material. No particular form of disclosure has to be used. The present application fully complies with the requirements of the statute. There is absolutely no disclaimer of the incorporation of the claim limitation as to Fig. 13. Further, there is no prohibition in the statute to mixing and matching features disclosed among various embodiments into an embodiment that is not expressly described. The concluding paragraph of the application makes clear that various combinations of disclosed features can be incorporated into a single embodiment. Thus, the mere fact, which is admitted in the office action, that there is a description of the claim limitation is sufficient support for the presently pending claims.

New claim 87 is added. Support for claim 87 may be found, for example, on pp. 31-32 of the Application.

It is respectfully submitted that the rejection of the claims as failing to comply with the written description requirement is in error, and therefore withdrawal of the rejection is respectfully requested. The Commissioner is authorized to charge any deficiencies and credit any overpayments to Deposit Account No. 13-2546.

Respectfully submitted,

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Date

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